

REMARKS

With entry of the instant amendment, claim 1 has been amended and claims 21-25 have been added. Claims 2-20 were previously cancelled. Accordingly, claims 1 and 21-25 are pending in the application.

The amendments to the specification: 1) amend the title to more accurately reflect the invention claimed in this application, 2) update the priority information, below, and 3) add federal funding support. The amendment to the title is also reflected in the supplemental ADS filed herewith.

The amendments to the drawings replace sheets 1-10 that were filed with the application with formal versions of the drawings, sheets 1-9. Figures 9 and 10 appear on one sheet of the formal drawings.

The amendments to the claims add no new matter and are supported throughout the application as filed. Claim 1 has been amended to recite an immune deficient SCID mouse. Support can be found, *e.g.*, on page 6, lines 30-31. Claim 1 has also been amended to recite that the mouse model recapitulates the development of primary tumors, micrometastasis, or formation of osteoblastic lesions characteristic of late stage prostate cancer. Support can be found, *e.g.*, on page 4, lines 17-20.

Claims 21, 22, and 23 recite that the xenograft is implanted subcutaneously (claim 21), intraprostatically (claim 22), or within a bone of the mouse (claim 23). Support can be found, *e.g.*, on page 10, line 36 bridging to page 11, line 3; and page 14, lines 17-18.

Claim 24 recites that the xenograft is from an explant selected from prostate, lymph node, lung, or bone tissue. Support can be found, *e.g.*, on page 7, lines 20-22.

Claim 25 recites that the xenograft is a prostate cancer cell suspension. Support can be found, *e.g.*, on page 9, lines 14-16.

For convenience, the objection/rejections will be addressed in the order presented in the August 23, 2004 Office Action.

Priority information

The first paragraph of the specification has been updated as required and also revised to indicate that the instant application is a continuation application, not a divisional application.

Oath/Declaration

The Examiner has required a new oath or declaration because the Declaration on file incorrectly designates 08/732,676 as a provisional application. A substitute Declaration is submitted herewith. It designates Application U.S. Ser. No. 08/732,676 as a non-provisional Application.

One of the inventors, Karen Klein, has not signed the substitute Declaration. Therefore, a petition under 37 C.F.R. § 1.183 to waive the requirements of 37 C.F.R. § 1.67, including proof of the pertinent facts, the fee set forth in § 1.17(h) and the last known address of the non-signing inventor accompanies this response. The petition explains that Applicants exercised diligence in attempting to obtain Dr. Klein's signature.

Obviousness-type double patenting

Claim 1 was rejected for alleged obviousness-type double patenting over claims 4-11 of U.S. Patent No. 6,365,797; over claims 1-4, 7-13, 16, and 17 of U.S. Patent No. 6,107,540; over allowed claims 21-27 of co-pending Application No. 10/062,925; and over allowed claims 21-27 of co-pending Application No. 10/062,738.

U.S. Patent No. 6,365,797, U.S. Patent No. 6,107,540, Application No. 10/062,925, Application No. 10/062,738 and the subject application are commonly owned by the Regents of the University of California. To the extent that the rejections apply to the amended claims, Applicants will gladly consider submitting appropriate terminal disclaimers. Applicants note that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. See, MPEP § 804.02.

Rejections under 35 U.S.C. § 102

Claim1 was rejected under 35 U.S.C. § 102(a) as allegedly anticipated by Liu *et al.* (*Int. J. Cancer* 65:85-89, 1996) and under 35 U.S.C. § 102(b) as allegedly anticipated by Pretlow *et al.* (*J. Natl. Can. Inst.* 85:394-398, 1993). Applicants respectfully traverse.

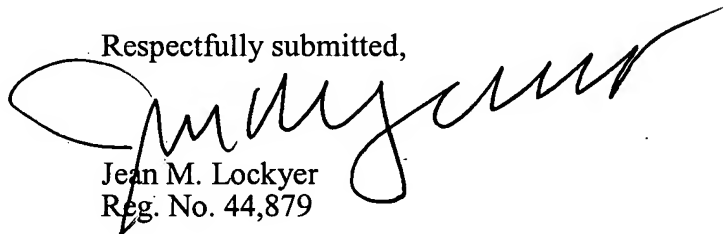
As the Examiner knows, in order for a reference to anticipate an invention, the reference must teach each and every element of the claimed invention (*e.g.*, MPEP § 2131). Claim 1 recites an immune deficient SCID mouse. Liu *et al.* describe experiments using a human prostate cancer xenograft, LuCaP 23.1, and mice that are congenitally athymic, *nu/nu* mice. Pretlow *et al.* describe transplanting primary prostate tumors to athymic nude mice. Thus, neither reference discloses a SCID mouse model as set forth in the instant claims. Accordingly, the references do not anticipate claim 1. Applicants therefore respectfully request withdrawal of the rejections.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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Attachments
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60427199 v1

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Reply to Office Action of August 23, 2004

PATENT

Amendments to the Drawings:

Please replace sheets 1-10 in the application as filed with the attached replacement sheets 1-9 (Figs. 9 and 10 now appear on one sheet). The replacement sheets are formal versions of the drawings as filed with the application. Accordingly, annotated sheets showing changes are not provided.